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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/629,678	08/01/2000	David Michael Schertz	11302-0434	7122

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EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 07/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/629,678

Applicant(s)

SCHERTZ ET AL.

Examiner

Judy M. Reddick

Art Unit

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspond nce address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 4/7/03;4/21/03;5/27/03;6/4/03.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12,14-25 and 27-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12,14-25 and 27-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/14/03 has been entered.

### *Information Disclosure Statement*

2. The information disclosure statement filed 04/07/03 has been considered and placed in the application file.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
*The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.*
4. Claims 1-12, 14-25 and 27-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

*The recited "about 50 to about 99% by weight of an unmodified polyvinyl alcohol and about 49 to about 1% by weight of a thermoplastic elastomer" per claims 1, 17 and 30 constitutes indefinite subject matter as per a) certain permutations would not engender a true composition, viz., 100 wt.% and b) it is not readily ascertainable as to the exact entity that said contents are being based on, i.e., unmodified polyvinyl alcohol and/or thermoplastic elastomer or unmodified polyvinyl alcohol + thermoplastic elastomer + unrecited component(s) or else. It is suggested that applicants adopt the following language so as to avoid any ambiguities: after "thermoplastic elastomer", insert "wherein, the contents of unmodified polyvinyl alcohol and thermoplastic elastomer are based on the unmodified polyvinyl alcohol and thermoplastic elastomer blend", as provided for at page 11, lines 29-31 of the specification.*

### *Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art*

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*are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

6. *The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:*

1. *Determining the scope and contents of the prior art.*
2. *Ascertaining the differences between the prior art and the claims at issue.*
3. *Resolving the level of ordinary skill in the pertinent art.*
4. *Considering objective evidence present in the application indicating obviousness or nonobviousness.*

7. *This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).*

8. *Claims 1-12, 15-25 and 28-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwanami et al (U.S. 4,349,644).*

*Iwanami et al disclose articles, such as film and fibers, derived from a melt-blended resin composition comprising at least two kinds of hydrolyzed ethylene-vinyl acetate copolymers and other additives which include thermoplastic resins such as melt moldable polyvinyl alcohol, ethylene-propylene-diene copolymers, ethylene/alpha olefins having at least 4 carbon atoms, polyester elastomer, synthetic rubber, etc. wherein, the ratio of the mixture of copolymers to the other thermoplastic resins is from 99:1 to 50:50. See, e.g., the Abstract, cols. 3-4 and the claims of Iwanami et al.*

*The disclosure of Iwanami et al differs basically from the claimed invention in the non-express disclosure directed to a specific combination of polyvinyl alcohol and thermoplastic elastomer, as claimed. However, based on their art recognized equivalency, it would have been obvious to the skilled artisan to use a combination of polyvinyl alcohol and e.g., a polyester elastomer and with a reasonable expectation of success, absent some evidence of unusual or unexpected results, commensurate in scope with the claims. Consult In re Ruff (118 USPQ 343).*

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*The use of any commercially available polyvinyl alcohol in lieu of the disclosed polyvinyl alcohol component of Iwanami et al would have been obvious to the skilled artisan and with a reasonable expectation of success. As to the dependent claims, the limitations are either taught by Iwanami et al, suggested by Iwanami et al or would have been obvious to the skilled artisan and with a reasonable expectation of success.*

**Allowable Subject Matter**

9. *Claims 14 and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.*

**Response to Arguments**

10. *Applicant's arguments filed 05/27/03 have been fully considered but they are not persuasive.*

*Relative to Iwanami et al*—*It is urged and maintained that the instantly claimed invention is obvious within the meaning of 35 USC 103 over Iwanami et al as per reasons clearly set forth in the Grounds of Rejection supra. The crux of Counsel's arguments appears to hinge the content of polyvinyl alcohol component. With all due respect to Counsel's opinion, the content of polyvinyl alcohol, operable within the scope of patentees invention as recited at col. 4, lines 8-38, falls smack-dab within the scope of the content of polyvinyl alcohol, as claimed. As to the "consisting essentially of" clause, such limits the scope of the claim to the specified ingredients and those that do not materially affect the basic and novel characteristics of applicants' composition as provided for under the guise of Ex parte Davis(80 USPQ 448) and In re Janakirama-Rao(137 USPQ 893). Applicants have simply not demonstrated on this record that the "hydrolyzed ethylene-vinyl acetate copolymer" mixture of Iwanami et al would materially affect the basic and novel characteristics of applicants' composition.*

*An attempt to place the case in condition for allowance via incorporating the limitations of claims 14 and 27 into claims 1 and 17, respectively, and modifying the content of unmodified polyvinyl alcohol/thermoplastic blend per claim 30, consistent with the limitations per claims 14 and 27, in terms of content was made. However, an agreement could not be reached.*


**Conclusion**


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*Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..*

*If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.*

*Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.*

  
Judy M. Reddick  
Primary Examiner  
Art Unit 1713

JMR   
June 25, 2003